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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,899

07/21/2006

Mads Eskelund Bjornvad

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EXAMINER

SINGH, SATYENDRA K

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,899	Applicant(s) BJORNVAD, MAD S ESKE LUND	
	Examiner SATYENDRA K. SINGH	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's preliminary amendment to the claims filed on July 21st 2006 is duly acknowledged.

Claims 1-22 are canceled by applicants.

Claims 23-42 are pending in the application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 23-31, drawn to a method for testing an enzyme of interest or screening a library of polypeptides for an enzyme of interest as recited in claim 23.

Group II, claim(s) 32-42, drawn to a method for testing a host cell or screening a library of host cells for expression of an enzyme of interest as recited in claim 32.

(a) An international or national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those invention involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) a product and a process specially adapted for the manufacture of said product; or
 - (2) a product and a process of use of said product; or
 - (3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
 - (4) a process and an apparatus or means specifically designed for carrying out said process; or
 - (5) a product, a process specially adapted for the manufacture of the said product and an apparatus or means specifically designed for carrying out said process.
- (c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

The groups I and II of inventions do not fall within any of the categories as discussed above. PCT Rule 13.2 does not provide for multiple compositions or multiple methods of use within a single application. Thus, the first appearing composition is combined with a corresponding first method of use and the additional composition and method claims each constitute a separate group.

The inventions of groups I and II, as claimed are directed to two distinct processes. The invention of group I requires “testing an enzyme of interest or screening a library of polypeptides”, whereas the invention of group II requires “testing a host cell or screening a library of host cells for expression of an enzyme”. The methods are patentably distinct as they use different steps/components, and result in distinct end points.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specie Election

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species are as follows:

Group I. If applicant elects the invention of group I, a single specie from EACH of the following sections must be elected for examination:

- A. **“enzymes capable of producing hydrogen peroxide** (claim 26)-
a glucose oxidase (E.C. 1.1.3.4),
a cellobiose oxidase (E.C. 1.1.3.25),
an alcohol oxidase (E.C.1.1.3.13),
a galactose oxidase (E.C. 1.1.3.9),
a L-amino acid oxidase (E.C.1.4.3.2)
- B. **“the enzyme of interest”** as recited in claims (27 + 29 + 31)-
a glucoamylase (E.C. 3.2.1.3),
a beta-glucosidase (E.C.3.2.1.21),
a pectinesterase (E.C. 3.1.1.11),
a alpha-galactosidase (E.C. 3.2.1.22),
cellulase (E.C.3.2.1.4),
a cellulose 1,4-beta-cellobiosidase (E.C. 3.2.1.91),
a lactase (E.C.3.2.1.108), a beta-galactofuranosidase,

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a carboxypeptidase A, (E.C. 3.4.17.1),
a glucose oxidase (E.C. 1.1.3.4),
a cellobiose oxidase (E.C. 1.1.3.25),
an alcohol oxidase (E.C. 1.1.3.13),
a galactose oxidase (E.C. 1.1.3.9) and
a L-amino acid oxidase (E.C.1.4.3.2)

Group II. If applicant elects the invention of group II, a single specie from EACH of the following sections must be elected for examination:

A. **“enzymes capable of producing hydrogen peroxide (claim 37)-**

a glucose oxidase (E.C. 1.1.3.4),
a cellobiose oxidase (E.C. 1.1.3.25),
an alcohol oxidase (E.C.1.1.3.13),
a galactose oxidase (E.C. 1.1.3.9),
a L-amino acid oxidase (E.C.1.4.3.2)

B. **“the enzyme of interest” as recited in claims (38+40+42)-**

a glucoamylase (E.C. 3.2.1.3),
a beta-glucosidase (E.C.3.2.1.21),
a pectinesterase (E.C. 3.1.1.11),
a alpha-galactosidase (E.C. 3.2.1.22),
cellulase (E.C.3.2.1.4),
a cellulose 1,4-beta-cellobiosidase (E.C. 3.2.1.91),
a lactase (E.C.3.2.1.108), a beta-galactofuranosidase,
a carboxypeptidase A, (E.C. 3.4.17.1),
a glucose oxidase (E.C. 1.1.3.4),
a cellobiose oxidase (E.C. 1.1.3.25),
an alcohol oxidase (E.C. 1.1.3.13),
a galactose oxidase (E.C. 1.1.3.9) and
a L-amino acid oxidase (E.C.1.4.3.2)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 23 (group I), and 32 (group II).
The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Pursuant to PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(I)(B)(2), the species are not art-recognized equivalents.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SATYENDRA K. SINGH whose telephone number is (571)272-8790. The examiner can normally be reached on 9-5MF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sandra Saucier/
Primary Examiner, Art Unit 1651

/Satyendra K. Singh/
Examiner, Art Unit 1657